



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,462	06/09/2000	Tracy E. Grim	480032-307	4478

7590

07/29/2003

ALAN C. ROSE, ESQ.
OPPENHEIMER WOLFF & DONNELLY LLP
840 NEWPORT CENTER DRIVE., SUITE 700
NEWPORT BEACH, CA 92660

EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 07/29/2003

30

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

CH

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER

ART UNIT	PAPER
----------	-------

30

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The amendment filed on 7/14/03 is considered to be non-responsive, see attached letter and OG Notice.

A one month shortened statutory time period is set for application to respond to this letter and the prior office action.

Marie Patterson
Primary Examiner
Art Unit: 3728

Art Unit: 3728

1. The amendment filed 7/14/03 does not comply with the regulations. Specifically, the amendment appears to use the new 37 CFR 1.121 format. However, that format does not apply to reissues.

2. Because the amendment appears to be a *bona fide* attempt to response to the action mailed 4/11/03, a new one month shortened statutory period for filing an amendment in proper format is set with this letter. If the proper amendment format is not followed, amendments will not be entered, and that any future failure to comply with the regulation that occurs in this application may result in a holding that the amendment is not a *bona fide* attempt to reply to the outstanding office action. Reissue amendments are filed under 37 CFR 1.173. The attached OG Notice clearly states that the reissues are NOT amended under the new 37 CFR 1.121 practice.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728

United States Patent and Trademark Office OG Notices: 25 February 2003

Amendments in a Revised Format Now Permitted

The United States Patent and Trademark Office (USPTO or Office) is permitting applicants to submit amendments in a revised format as set forth herein. The revised amendment format is essentially the same as the amendment format that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. The Office plans to adopt such a revision to 37 CFR 1.121 by July of 2003, at which point compliance with revised 37 CFR 1.121 will be mandatory.

The revised amendment format is an expansion of the special amendment process instituted for a prototype Electronic File Wrapper program described in USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING, 1265 Off. Gaz. Pat. Office 87 (Dec. 17, 2002) ("Prototype Announcement"). The special amendment process (which was limited to claims) has proven overwhelmingly acceptable to applicants participating in the prototype and beneficial to examiners. The revised amendment format provides for amendments to be made to the specification and the drawings in addition to the claims.

Effective immediately, all applicants, including applicants participating in the prototype, may submit amendments using the revised amendment format set forth herein. Applicants may wish to submit all amendments in the revised amendment format because: (1) it will facilitate transition to a revised amendment format when it becomes mandatory, (2) inconsistent versions of claim amendments (clean and marked-up) will be avoided, and (3) time and resources will be saved.

WAIVER of 37 CFR 1.121

The provisions of 37 CFR 1.121(a), (b), (c) and (d) are waived for amendments to the claims, specification, and drawings in all applications in all Technology Centers where the amendments comply with the revised amendment format detailed below. ~~Note: The revised amendment format (and the waiver) does not apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 for reissue applications and 37 CFR 1.530 (d)-(k) for ex parte and inter partes reexaminations.~~ *

In addition, the WAIVER indicated in the above mentioned Prototype Announcement for the limited (claims only) amendment process of that prototype is also expressly continued and amendments in applications (other than reissue applications) in all Technology Centers that comply with the requirements in that announcement will be acceptable.

REVISED AMENDMENT FORMAT

I. Begin Sections on Separate Sheets:

Each section of an amendment paper (e.g., Amendments to the Specification, Amendments to the Claims, Remarks) shall begin on a separate sheet to facilitate separate indexing and electronic scanning of the document.

For example, each of the following four sections of an amendment paper must start on a separate sheet:

- a.) Introductory Comments
- b.) Amendments to the Specification
- c.) Amendments to the Claims
- d.) Remarks

II. Submit Only One Version (with markings) of an Amended Part:

The requirement to provide two versions of a replacement paragraph, section, or claim (a clean version and a marked up version), as set forth in current 37 CFR 1.121, is waived where the format set forth below is followed.

III. Amendments to the Claims

A. A Complete Listing of Claims is Always Required:

If an amendment adds, changes or deletes any claim, a detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remains under examination in the application, must be presented, and the amendment to the claims is expressed in the listing. The listing shall be presented as follows:

1. Ascending Order and Status Identifier Required

The listing shall be provided in sequential ascending numerical order (beginning with claim 1). A status identifier shall be provided for every claim in a parenthetical expression following the claim number (e.g., "Claim 1. (original)"). A list of acceptable status identifiers is set forth in part B, below. The text of all claims under examination shall be submitted each time any claim is amended. Cancelled and withdrawn claims should be indicated by only the claim number and status. The text of cancelled or withdrawn claims should not be presented.

2. Markings in Currently Amended Claims Required

All claims being currently amended shall be submitted with

markings to indicate the changes that have been made relative to the immediate prior version of the claims. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). No separate "clean" version should be submitted for currently amended claims, as this requirement has been eliminated. Markings should only be made in claims being currently amended in an amendment paper.

3. Only Clean Text Required for Other Claims Under Examination.

The text of pending claims not being currently amended that are under examination shall be presented in a clean version in the listing. Any claim presented in clean version constitutes an assertion that it has not been changed relative to the immediate prior version.

4. Status to Effect Claim Cancellation or Addition.

A claim may be cancelled by merely indicating the status of the claim as cancelled. Any new claim added by amendment must be indicated by the appropriate status identifier and shall not be underlined. Thus, added new claims of status (new), (reinstated - formerly claim #_) and (re-presented - formerly dependently claim #_) must be presented in clean version. Additional claims may be subject to additional fees, as appropriate.

5. When Grouping of Claims is Permitted.

Consecutive cancelled or withdrawn claims may be aggregated into one line of the listing (e.g. Claims 1 - 5 (cancelled)).

6. Use "Currently Amended" Status Where Applicable.

If any "previously reinstated" or "previously re-presented" claim is being amended, the status shall be indicated as "currently amended" with markings as indicated in paragraph A2, above. Multiple status identifiers should not be used for any single claim.

B. Status Identifiers that May be Used:

In order to promote uniformity and consistency, only the following eleven (11) defined status identifiers should be used to indicate the status of the claims (in parentheses after the claim number):

1. (Original): Claim filed with the application following the specification (i.e., not added by preliminary amendment).

2. (Currently amended): Claim being amended in the current amendment paper.

3. (Previously amended): Claim not being currently amended, but which was amended in a previous amendment paper.
4. (Cancelled): Claim cancelled or deleted from the application.
5. (Withdrawn): Claim still in the application, but in a non-elected status.
6. (Previously added): Claim added in an earlier amendment paper.
7. (New): Claim being added in the current amendment paper.
8. (Reinstated - formerly claim # _): Claim deleted in an earlier amendment paper, but re-presented with a new claim number in current amendment.
9. (Previously reinstated): Claim deleted in an earlier amendment and reinstated in an earlier amendment paper.
10. (Re-presented - formerly dependent claim # _): Dependent claim re-presented in independent form in current amendment paper.
11. (Previously re-presented): Dependent claim re-presented in independent form in an earlier amendment, but not currently amended.

C. Example of Listing of Claims:

Claims 1-5 (cancelled)

Claim 6 (withdrawn)

Claim 7 (previously amended): A bucket with a handle.

Claim 8 (currently amended): A bucket with a green blue handle.

Claim 9 (withdrawn)

Claim 10 (original): A bucket with a wooden handle.

Claim 11 (cancelled)

Claim 12 (new): A bucket with plastic sides and bottom.

Claim 13 (previously added): A bucket having a circumferential upper lip.

Claim 14 (re-presented - formerly claim 11): A black bucket with a wooden handle.

IV. Amendments to the Specification

Amendments to the specification are to be made by presenting replacement paragraphs, sections or a substitute specification marked up to show changes made relative to the immediate prior version, as set out in 37 CFR 1.121(b). The changes should be shown by strikethrough (for deleted matter) or underlining (for added matter). No accompanying "clean" version shall be supplied. The amendments to the specification shall be presented only one time, and will not appear in successive amendment documents.

V. Amendments to the Drawings

Amendments to the drawing figures shall be made by presenting replacement figures which include the desired changes, without markings, and which comply with \s 1.84. The changes shall be explained in the accompanying remarks section of the amendment paper. If the amended drawings are not approved, the applicant will be notified in the next Office action. Any amended drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure number in the amended drawing should not be labeled as "amended."

For further information on the prototype image electronic processing of patent applications, please contact the Search and Information Resources Administration at: image.processing@uspto.gov. Any questions regarding the submission of amendments pursuant to the revised practice set forth in this notice should be directed to Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (mailto:Joseph.Narcavage@uspto.gov). For information on the waiver or legal aspects of the program, please contact Jay Lucas (Jay.Lucas@uspto.gov) or Rob Clarke (Robert.Clarke@uspto.gov).

January 31, 2003

STEPHEN G. KUNIN
Deputy Commissioner for
Patent Examination Policy



Amendments Permitted under the Revised Amendment Practice and Treatment of Non-Compliant Amendments

Office of Patent Legal Administration << Pre-OG Notices << Amendments Permitted under the Revised Amendment Practice and Treatment of Non-Compliant Amendments

SUMMARY:

Amendments submitted prior to July 30, 2003 in compliance with the previous version of 37 CFR 1.121 or the revised version promulgated in the Notice of Final Rule Making: **Changes To Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 38611** (June 30, 2003) (**Revised Amendment Practice**) will be accepted. Amendments filed on or after July 30, 2003, **must** be submitted in compliance with revised 37 CFR 1.121. The previously announced limited waivers permitting submission of amendments in the voluntary revised amendment format terminate on July 29, 2003. If a preliminary amendment or a reply under 37 CFR 1.111 filed on or after July 30, 2003 includes one or more non-compliant sections, applicant will be notified via a Notice of Non-Compliant Amendment that the non-compliant section(s) needs to be re-submitted in compliant form within a period set by the Office.

BACKGROUND

The United States Patent and Trademark Office (Office) previously announced a prototype program to evaluate the electronic image processing of patent applications using the image file wrapper system (IFW). **See USPTO Announces Prototype of Image Processing, 1265 Off. Gaz. Pat. Office 87** (December 17, 2002). The notice included a limited waiver of 37 CFR 1.121 (available in applications being examined in the prototype program) which permitted amendments to be submitted in a voluntary revised amendment format. The limited waiver was later extended to all applications. **See Amendments in a Revised Format Now Permitted, 1267 Off. Gaz. Pat. Office 106** (February 25, 2003). The Office revised its rules of practice to implement image file wrapper processing, including the Revised Amendment Practice, taking into account public comments, in the above-noted notice of final rule making, which is effective on July 30, 2003. Many members of the public have requested that the Office permit amendments to be submitted in compliance with the revised version of 37 CFR 1.121 before the effective date of July 30, 2003 in order to provide for a smoother transition to the new practice. This Notice adopts the suggestion.

WAIVER OF 37 CFR 1.121 UNTIL JULY 29, 2003

The provisions of 37 CFR 1.121(a), (b), (c) and (d) are hereby waived for amendments to the claims, specification, and drawings, filed before July 30, 2003 in all applications where the amendments comply with 37 CFR 1.121 effective on July 30, 2003. **Note:** The revised amendment rules (and this waiver) **do not** apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 and 37 CFR 1.530(d)-(k), respectively.

US 76

TREATMENT OF NON-COMPLIANT AMENDMENTS

All amendments received by the Office on or after July 30, 2003 **must** be in compliance with the rules as required by the Revised Amendment Practice. This practice requires the submission of an amendment document that includes separate sections for amendments to the claims, drawings, specification and abstract, each beginning on a new sheet of paper. If an amendment is received

as a preliminary amendment or as a *bona fide* reply under 37 CFR 1.111, the amendment has compliant amendments to one or more separate section(s), but also includes one, or more, separate section(s) with non-compliant amendments, the Office will mail a Notice of Non-Compliant Amendment requiring correction to the non-compliant section(s) within a time period set by the Office. When making corrections, applicant should just resubmit the needed corrected section(s), and correspondingly, should not resubmit the entire amendment document. For example, if the amendment included compliant amendments to the specification and claims, and non-compliant amendments to the drawings, a notice requiring resubmission of compliant amendments to the drawings would be sent. In reply to the notice, applicant should only submit a compliant amendment to the drawings, and not the previously compliant amendments to the specification and claims. If any additional, or further, amendments to the claims are desired, the changes must be made relative to the previous compliant amendment to the claims. The Office will consider both the previous compliant amendment to the claims, and the supplemental compliant amendment to the claims, after the Office receives the compliant amendment to the drawings.

An amendment submitted on or after July 30, 2003 as part of a reply after the close of prosecution (e.g., as a reply under 37 CFR 1.116) that is not compliant with the Revised Amendment Practice will not act to toll the outstanding time period. See 37 CFR 1.135(c). A notice (e.g., an advisory action) may be mailed by the Office specifying which section(s) of the amendment was not in compliance with the Revised Amendment Practice, but no new time period will be given to provide a compliant section.

FOR FURTHER INFORMATION CONTACT:

Questions concerning this notice may be submitted to Joseph Narcavage, Elizabeth Dougherty or Eugenia Jones by e-mail at joseph.narcavage@uspto.gov or by telephone at (703) 305-1622.

Date: 07/11/2003

Signed: /s/

STEPHEN G. KUNIN
Deputy Commissioner
for Patent Examination Policy

**HOME | INDEX | SEARCH | SYSTEM STATUS | BUSINESS CENTER |
NEWS&NOTICES |
CONTACT US | PRIVACY STATEMENT**

Last Modified: Monday, July 14, 2003 16:31:32